

TTAB



ATTORNEY DOCKET NOS.: USC02 028 and USC02 048

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

**THE CHAMBER OF COMMERCE OF THE
UNITED STATES OF AMERICA**

Opposer,

v.

**UNITED STATES HISPANIC CHAMBER
OF COMMERCE FOUNDATION**

Applicant.

Opposition No. 91156321
("parent" case)

Opposition No. 91156340
("child" case)



12-31-2003

U.S. Patent & TMO/TM Mail Rpt Dt. #22

TRANSMITTAL

Trademark Trial and Appeal Board
Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

Sir:

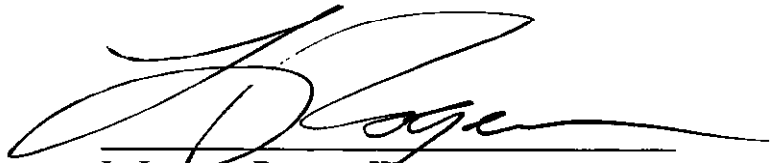
Transmitted herewith is an Opposer's Reply to Applicant's Response to Opposer's Motion to Require Surrender of Registration No. 2,777,830 to Consolidate the Pending Proceedings, and to Reset Discovery and Testimony Periods in the Consolidated Proceeding and a copy of the Opposer's pending motion to consolidate the two pending proceedings (in triplicate); and Opposer's Opposition to Applicant's Motion to Dismiss

Opposer's Opposition to Registration of Applicant's First Mark for Lack of Jurisdiction
(in triplicate) for the above-identified proceedings.

If a Petition for an Extension of Time is necessary for the paper transmitted herewith to be timely filed, this transmittal is to be considered as a petition to extend the response period by the amount of time needed for the papers to be timely filed.

The Commissioner is hereby authorized to charge payment of any additional fees associated with this communication or credit any overpayment to Deposit Account No. 04-1679. A duplicate of this sheet is enclosed.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "L. Lawton Rogers, III", written over a horizontal line.

L. Lawton Rogers, III
Mark C. Comtois
Attorneys for Opposer

DUANE MORRIS LLP
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Telecopier: (202) 776-7801

Date: December 31, 2003

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Applicant, United States Hispanic Chamber Of Commerce, has opposed the motion solely on procedural grounds, i.e., (1) that Opposer failed to state the grounds for the motion and (2) that the motion failed to embody a brief. Applicant's factual inaccuracy is apparent from the motion.

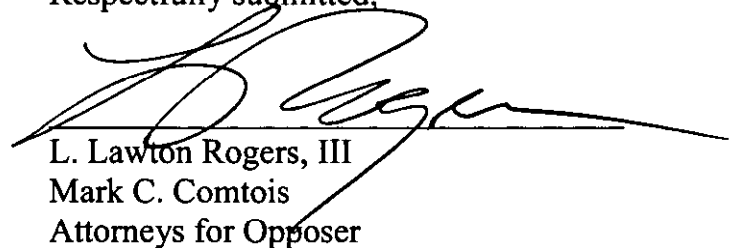
Applicant acknowledges that Opposer has set forth facts and seems to be saying that these facts following "As grounds for this motion . . ." (Motion , p.2) are only "facts" and not "grounds". Applicant appears to be under the misapprehension that "grounds" require "support", and that "support" is something other than "facts," for Applicant baldly states that Opposer "fails to set forth any support for the grounds" (Response, p.2). Opposer's motion clearly embodies Opposer's position regarding the existence of error, the lack of prejudice to Applicant and the benefits of consolidation to the parties and the Board. *Res Ipsa Loquitur*, and no further response is required.

It is noted that Applicant's attempt at a substantive opposition to Opposer's Motion to Consolidate is the bare conclusory statement that the respective marks "are visually and phonetically different" for "different services" in different classes. (Response , p.2). While such conclusions may be relevant to the ultimate outcome, they are not relevant to the issue of consolidation. Applicant's argument that the evidence "may be different" (Response, p.2, emphasis added) is a tacit admission that the evidence in the two proceedings will be the same, with Applicant conveniently ignoring the fact that Applicant has filed identical counterclaims in both oppositions, and the fact that the registrations on which Opposer relies are also identical in both oppositions.

Similarly, Applicant baldy states that the solution proposed by Oppose “would unfairly prejudice Applicant” (Response, p.2) but makes no attempt to identify the prejudice, *a fortiori* to speak to relative prejudice.

As set out in Opposer’s Motion, many of the issues are common to both proceedings, significant judicial economy will be realized by consolidation, and resetting of the periods will obviate the present confusion generated by the differing posture of the proceedings and permit the orderly and simultaneous resolution of all issues. Applicant’s procedural opposition is specious, and Opposer’s Motion has not been substantively opposed and should be granted.

Respectfully submitted,



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Dated: December 31, 2003

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true copy of the foregoing

**OPPOSER'S REPLY TO APPLICANT'S OPPOSITION
TO OPPOSER'S MOTION
TO REQUIRE SURRENDER OF REGISTRATION NO. 2,777,830,
TO CONSOLIDATE THE PENDING PROCEEDINGS ,
AND
TO RESET DISCOVERY AND TESTIMONY PERIODS IN THE
CONSOLIDATED PROCEEDING**

was served on Attorney for Applicant, Evan R. Sotiriou, at his address of record,
Armstrong Teasdale LLP, One Metropolitan Square, Suite 2600, St. Louis, Missouri
63102-2740, by depositing same with the United States Postal Service, first-class mail,
postage prepaid, this 31st day of December, 2003.

A handwritten signature in black ink, appearing to be "R. Sotiriou", written over a horizontal line.

Applicant.

Opposition No. 91156340
("child" case)

Opposer, The Chamber of Commerce of The United States of America, has moved the Board for an order (a) requiring surrender of the Registration No. 2,777,830, (b) to consolidate the pending proceedings Nos. 91156321 and 91156340 between Opposer and Applicant, and (c) to reset the discovery and testimony periods of the consolidated proceeding.

Applicant, United States Hispanic Chamber Of Commerce, has opposed the motion solely on procedural grounds, i.e., (1) that Opposer failed to state the grounds for the motion and (2) that the motion failed to embody a brief. Applicant's factual inaccuracy is apparent from the motion.

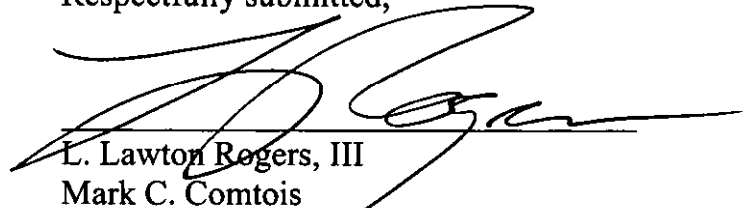
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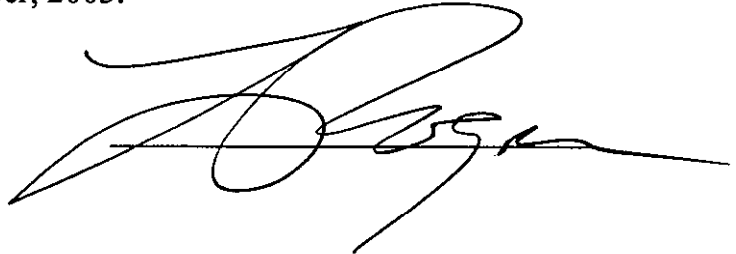
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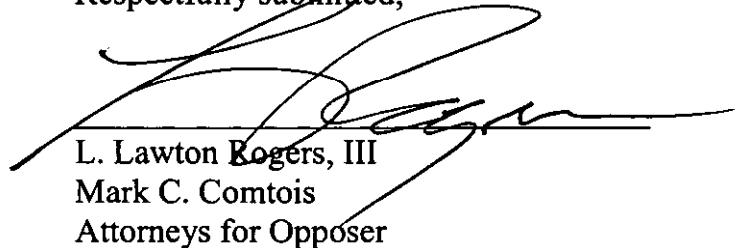
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TO OPPOSER'S MOTION
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TO CONSOLIDATE THE PENDING PROCEEDINGS ,
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The chronology of events is set out in greater detail in Opposer's pending motion to consolidate the two pending proceedings (copy attached). Briefly,

- Opposer timely filed a Notice as to Applicant's First Mark, which contained a typographical error referring ambiguously to Applicant's Second Mark;
- Opposer filed a Corrected Notice amending the Notice as to Applicant's First Mark to correct the typographical error;
- Opposer timely filed a Notice as to Applicant's Second mark

Applicant attempts to achieve a procedural victory and to circumvent a decision on the merits by mischaracterizing Opposer's Corrected Notice as an untimely filed notice, i.e., Applicant asserts that the initial Notice was directed to the Second Mark and that the Corrected Notice was directed to Applicant's First Mark, but was untimely filed and therefore must now be dismissed.

As clearly shown by the transmittal for the Corrected Notice, Opposer sought to amend the initially filed Notice to correct the typographical error so that it was unambiguously directed to the First Mark. Clearly, the Trademark Trial and Appeal Board ("TTAB") clearly has the authority to accept corrected pleadings amending initially filed pleadings on such terms as the TTAB deems appropriate. 37 CFR § 2.107 provides :

37 CFR § 2.107 Amendment of pleadings in a opposition proceeding

Pleadings in an opposition proceeding may be amended in the same manner and to the same extent as in a civil action in a United States District court.

28 United States Code, Section 1653 governs the amendment of pleadings in a United States District court and provides:

§ 1653 Amendment of pleadings to show jurisdiction

Defective allegations of jurisdiction in pleadings may be amended, upon terms, in the trial or appellate courts.

Here, Opposer discussed the procedure to be followed with the TTAB, submitted a Corrected Notice amending the originally filed Notice (see the Transmittal), and the TTAB unconditionally accepted the Corrected Notice. Clearly the TTAB acted within its authority in permitting the amendment of the Notice filed in the initial proceeding. Thus, the Corrected Notice is entitled to the filing date of the Notice and thus was timely filed. Because it was timely filed, Applicant's motion to dismiss must be denied.

DISCUSSION

As set out in more detail in Opposer's pending motion to consolidate these proceedings (copy attached), Opposer timely filed its opposition to Applicant's First Mark with a typographical error in the serial number that ambiguously identified the opposed application as the Second Mark. After consultation with the TTAB regarding the procedure to be followed, Applicant filed a Corrected Notice which amended the Notice. Opposer understood that the Corrected Notice was an amendment of the timely filed Notice and was to be placed in the same file as a substitute for the Notice.

Despite the clear import of the papers forwarding the Corrected Notice and the notation in the file, the TTAB erroneously instituted a second proceeding rather than substituting the Corrected Notice for the Notice.

When Opposer subsequently and timely filed its opposition to Applicant's Second Mark, the TTAB initiated a third proceeding. Thus the TTAB initiated three proceedings for two applications. When the TTAB realized that it had one too many proceedings, it terminated one of the proceedings, unfortunately the wrong one of the proceedings, i.e., the TTAB erroneously terminated the last proceeding to be initiated rather than placing the Corrected Notice in the first to be initiated proceeding and terminating the erroneously initiated second to be initiated proceeding.

In its motion to dismiss, Applicant contends:

- (1) that the first to be initiated proceeding was directed to the Applicant's Second Mark;
- (2) that the second to be initiated proceeding was directed to Applicant's First Mark, was filed out of time, and should be dismissed; and
- (3) that the third to be initiated proceeding was directed to Applicant's Second Mark, is a duplicate of the first to be initiated proceeding, and was properly dismissed.

The result of the granting of Applicant's present motion would be to leave pending only one proceeding, the first to be initiated proceeding, and would direct that proceeding to Applicant's Second Mark allowing Applicant's First Mark to register.

In contrast, Opposer contends:

- (1) that the first to be initiated proceeding was properly directed to the Applicant's First Mark, albeit containing an erroneous serial number;

(2) that the second to be initiated proceeding should never have been initiated and should have been voided once the TTAB discovered that it had three proceedings for two marks; and

(3) that the third to be initiated proceeding was properly directed to Applicant's Second Mark and should not have been dismissed.

The result of the denial of Applicant's present motion would be to leave pending two proceedings, the first to be initiated proceeding against Applicant's First Mark and the third to be initiated proceeding directed to Applicant's Second Mark. Opposer's pending motion to consolidate the two proceedings will produce judicial economy in the resolution of both proceedings. More importantly, the result sought by Applicant will be highly prejudicial to Opposer and the denial thereof will not prejudice Applicant who has at all times contemplated the opposition to registration of both of its marks.

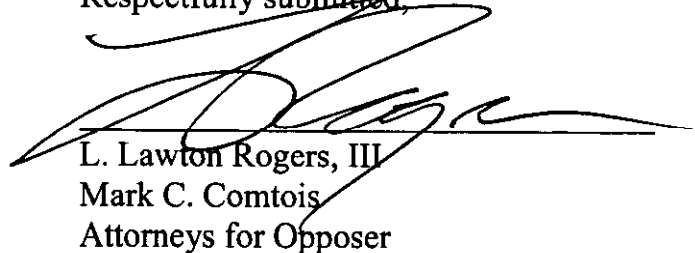
Finally, the papers submitted by Opposer in correcting the typographical error in the first Notice were submitted in conformity with the procedural advice of the TTAB and clearly indicate the action to be taken. The TTAB was clearly acting within the scope of its authority when it provided Opposer with instruction as to how to procedurally correct the Notice, Opposer filed the Corrected Notice to amend the Notice (See the Transmittal), and the TTAB was clearly acting within its statutory authority in accepting the Corrected Notice as an amendment of the Notice. (See 37 CFR § 2.107 and 28 U.S.C. § 1653.).

The TTAB committed error in ignoring the clear instructions of the Corrected Notice and instituting the second proceeding. This error was compounded by the

cancellation of the wrong proceeding without advising the parties and giving them the opportunity to object. The TTAB must now correct that error, and put the parties in the same position in which they would have been had the error not occurred, i.e., an ongoing opposition proceeding for both of Applicant's marks.

This result may be achieved procedurally by more than one path. The straightforward path is to acknowledge the errors (1) in instituting the second proceeding and (2) in canceling the third proceeding. However, the short path is the denial of Applicant's motion, leaving two present proceedings pending, and then consolidating those two proceedings so that the parties may reach the merits on both applications. Whatever the path, equity demands that Opposer have the opportunity to oppose the registration of both of Applicant's marks.

Respectfully submitted,



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**OPPOSER'S OPPOSITION TO
APPLICANT'S MOTION TO DISMISS OPPOSER'S OPPOSITION
TO REGISTRATION OF APPLICANT'S FIRST MARK
FOR LACK OF JURISDICTION**

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